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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/195,333	11/17/1998	ERIC VALENTINE	1190-2007	4205
27045	7590	07/22/2005	EXAMINER	
ERICSSON INC. 6300 LEGACY DRIVE M/S EVR C11 PLANO, TX 75024			SCHEIBEL, ROBERT C	
			ART UNIT	PAPER NUMBER
			2666	

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/195,333

Applicant(s)

VALENTINE ET AL.

Examiner

Robert C. Scheibel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see page 9, filed 4/11/2005, with respect to the objection to Figure 2 have been fully considered and are persuasive. The objection to Figure 2 has been withdrawn.
2. Applicant's arguments, see page 9, filed 4/11/2005, with respect to the objections to the specification have been fully considered and are persuasive. The objections to the specification have been withdrawn.
3. Applicant's arguments, see page 9, filed 4/11/2005, with respect to the objections to claims 1, 2, 7, and 9 have been fully considered and are persuasive. The objections to claims 1, 2, 7, and 9 have been withdrawn.
4. Applicant's arguments, see pages 9-11, filed 4/11/2005, with respect to the rejection of claims 1-6, 8-18, and 20 under 35 U.S.C. 102(e) have been fully considered and are persuasive as the claims have been cancelled. The rejection of claims 1-6, 8-18, and 20 under 35 U.S.C. 102(e) has been withdrawn.
5. Applicant's arguments, see page 11, filed 4/11/2005, with respect to the rejection of claims 1-9 and 13-16 under 35 U.S.C. 112, second paragraph, have been fully considered and are persuasive as the claims have been cancelled. The rejection of claims 1-9 and 13-16 under 35 U.S.C. 112, second paragraph, has been withdrawn.
6. Applicant's arguments, see page 11, filed 4/11/2005, with respect to the rejection of claims 7 and 19 under 35 U.S.C. 103(a) have been fully considered and are persuasive as the

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claims have been cancelled. The rejection of claims 7 and 19 under 35 U.S.C. 103(a) has been withdrawn.

***Claim Objections***

7. Claims **23 and 32** are objected to because the acronym PSTN (in lines 2 and 2-3, respectively) is not defined in its first use in the claims.
8. Claims **28 and 37** are objected to because the phrase “user/subscriber” should be changed to “user or subscriber” for clarity.
9. Claim **29** is objected to because the word “formatting” in line 4 should be changed to “formats”.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims **21-39** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
12. Claims **21 and 30** recite the limitation “the PSAP” in lines 13 and 10, respectively. There is insufficient antecedent basis for this limitation in the claim. These claims discuss a “PSAP compatible telephone number”, but not a PSAP.
13. Claims **21 and 30** are rejected because the phrase “the PSAP message being compatible with the” is not definite.

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14. Claims **22 and 31** recite the limitation "the PSAP" in line 4. There is insufficient antecedent basis for this limitation in the claim.
15. Claims **24 and 33** recite the limitation "the PSAP" in line 2. There is insufficient antecedent basis for this limitation in the claim.
16. Claims **28 and 37** recite the limitation "the user/subscriber" in line 4. There is insufficient antecedent basis for this limitation in the claim.
17. Claim **39** recites the limitation "the IP network" in line 2. There is insufficient antecedent basis for this limitation in the claim.
18. Claims **25-27, 29, 32, 34-36, and 38** are rejected as they are dependent on indefinite claims.

***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

21. Claims **21-39** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,161,180 to Chavous in view of U.S. Patent Application Publication 2001/0055299 to Kelly.

Regarding claims **21 and 30**, Chavous discloses the step of detecting an emergency request message in an emergency call handling function and the emergency call handling function (the combination of the call interceptor (CI) and the PBX of Chavous) in the panic button logic illustrated in elements 20 and 21 of Figure 2 as well as in the detection of the digits 9-1-1 in elements 17-19 of Figure 2. Chavous does not disclose the use of IP and as such does not use an IP address to identify a user. However, Chavous uses an extension number to identify the telephony device making the emergency request. Thus, the super step of translating an IP address associated with the emergency request message is generally disclosed as the translation of the extension telephone number identifying the telephone into the location of the extension telephone. Specifically, the step of retrieving information associated with the IP address (extension number) that includes a physical address and a PSAP compatible telephone number is disclosed in lines 21-40 of column 3; the physical address is the "location" described in lines 21-25 and 35-40 of column 3 and the PSAP number is inherent in that in order to dial PSAP as described in lines 30-34 the PSAP telephone number must be retrieved. The step of encapsulating the physical address information within a PSAP message for the PSAP is disclosed in lines 35-40 of column 3. The step of sending the PSAP message to the emergency call answering center is also disclosed in lines 35-40 of column 3. The above limitations were

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largely described using the language of claim 21, but the equivalent means of claim 30 are similarly disclosed in Chavous.

Chavous does not disclose expressly the limitation that the emergency call handling function is connected to an ISP or the limitation that the IP address of the calling device is translated.

However, at the time of the invention, it was well known that IP telephony could be used to provide many benefits such as reduced costs. Kelly is one example of this. Kelly discloses an IP telephone 232B of Figure 2 connected to a PBX. Clearly, this IP telephone would have an IP address in order to receive IP packets (see lines 5-8 of paragraph 38 on page 4, for example). As stated above, the PBX of Chavous was part of the emergency call handling function. Kelly thus discloses the limitation that the emergency call handling function is connected to an ISP as disclosed in Figure 2 (element 250A). Further, it is obvious that the IP address would have been used instead of an extension number. Chavous and Kelly are analogous art because they are from same field of endeavor of telephonic communication.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify Chavous to use IP telephony instead of or in addition to circuit switched telephony. The combination of Kelly and Chavous discloses all the limitations of claims 21 and 30 as Chavous, modified, translates IP address and/or extension telephone numbers to physical addresses and a PSAP compatible telephone number. The motivation for combining the teaching of Kelly with Chavous would have been reduced cost as suggested by Kelly in the last 4 lines of paragraph 7 on page 1. Therefore, it would have been obvious to combine Kelly with Chavous for the benefit of reduced cost to obtain the invention as specified in claims 21 and 30.

Regarding claims **22 and 31**, Chavous discloses the limitation of the encapsulating step further comprising the PSAP message including a telephone number of the PSAP assigned to a service zone covering the physical address in lines 30-34 of column 3; the PSAP number is clearly used to call the PSAP serving the calling telephone.

Regarding claims **23 and 32**, Chavous discloses the limitation of routing the PSAP message via a PSTN gateway (the PBX) into the PSTN and on to an appropriate central office (element 112) or a selected PSAP (108) in Figure 1.

Regarding claims **24 and 33**, Chavous discloses the limitation that the PSAP message is routed to the central office and the PSAP closest to the physical address associated with the Internet device (the calling telephone in Chavous as modified above) in lines 30-34 of column 3; it is well known that the PSAP serving the calling telephone is the closes PSAP.

Regarding claims **25-26 and 34-35**, Chavous, as modified above, discloses the limitation of the internet device having a static IP address as well as the limitation of the internet device having a dynamically assigned IP address. As discussed above, the Internet device (IP telephone 232B of Kelly) of Chavous modified by Kelly has an IP address. Lines 5-8 of paragraph 38 on page 4 disclose that this IP address is either static (fixed) or dynamically assigned.

Regarding claims **27 and 36**, Chavous, as modified above, discloses the limitation that the Internet device is a terminal in a LAN. The IP telephone 232A of Figure 2 can also be part of a LAN as described in the last 10 lines of paragraph 34 on pages 3-4 and illustrated in elements 275 and 232E of Figure 2.

Regarding claims **28 and 37**, Chavous, as modified above, does not explicitly disclose the limitation that the information associated with the IP address is associated in a database that



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includes account information required by the ISP to provide the Internet device access to the Internet, the information being associated with the user/subscriber and the Internet device. However, it does disclose that this information is located in a database (see lines 21-24 of column 3 of Chavous) and this includes information required to connect to the central office/PSAP. It is also clear that the PBX of Kelly must contain a database of information required for the user to access the Internet in order to effectively connect the ISP of Figure 2. At the time of the invention, it would have been obvious to one of ordinary skill in the art to store all this information related to the Internet device and the subscriber in one database. The motivation for doing so would have been to reduce the costs of the PBX system by reducing the memory requirements. Therefore, it would have been obvious to one of ordinary skill in the art to combine the location information of the calling telephone with information required to connect the device and user to the Internet for the benefit of reduced costs to obtain the invention as specified in claims **28 and 37**.

Regarding claims **29 and 38**, Chavous, as modified above, discloses the limitation that the call handing function is included within the PSTN gateway (the PBX) and that the gateway uses a protocol compatible with the emergency call answering center (the PSAP) to format a message containing the physical address associated with the Internet device (the calling telephone) in lines 35-40 of column 3 as discussed above.

Regarding claim **39**, Chavous, as modified above, discloses the limitation of the emergency call handling function being a separate element outside the IP network maintained by a third party administrator in lines 54-59 of column 1 which indicate that the PBX represents one of many different types of devices including a Centrex which is maintained by a third party.

*Conclusion*

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure; this prior art may be used in future rejections. U.S. Patent 5,347,567 to Moody et al discloses an apparatus and method for identifying a calling station. U.S. Patent 5,339,351 to Hoskinson et al discloses an emergency response system. U.S. Patent 6,463,051 to Ford discloses an Internet calling system. U.S. Patent 6,678,357 to Stumer et al discloses an IP emergency telephony connections system. U.S. Patent Application Publication 2005/0006109 to McSheffrey et al discloses a method for transmission of data to emergency response personnel.

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert C. Scheibel whose telephone number is 571-272-3169. The examiner can normally be reached on Monday and Thursday from 6:30-5:00 Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*RCS 7-11-05*  
Robert C. Scheibel  
Examiner  
Art Unit 2666

*Seema S. Rao*  
**SEEMA S. RAO** 7/19/05  
**SUPERVISORY PATENT EXAMINER**  
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